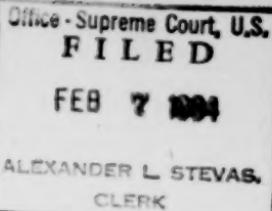


83-1304



NO.

IN THE
SUPREME COURT OF THE UNITED STATES

October Term, 1983

EMMA LEE PAUL,

Petitioner,

v.

ALEX HALEY, DOUBLEDAY & COMPANY, INC.;
DOUBLEDAY PUBLISHING CO., INC.; AMERICAN
BROADCASTING COMPANIES, INC.; AND
DELL PUBLISHING CO., INC.

Respondents.

PETITION FOR A WRIT OF
CERTIORARI TO THE UNITED STATES COURT OF
APPEALS FOR THE SECOND CIRCUIT

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February 7, 1984

QUESTIONS PRESENTED

1. Should a federal court exercise pendent jurisdiction over an unfair competition claim even though it has dismissed related copyright claims, where dismissal of the unfair competition claim might leave the plaintiff without any forum for relief due to the passing of the applicable state statute of limitations subsequent to the filing of the action in federal court?

2. Should a federal court allow a plaintiff in a copyright infringement action to have the right to a trial on the issue of whether copying has occurred, where similarities exist and access is not at issue?

PARTIES

Petitioner -- Appellant in the Court of Appeals and Plaintiff in the District Court -- is Emma Lee Paul. Respondents -- Appellees is the Court of Appeals and Defendants in the District Court -- are Alex Haley, Doubleday & Company, Inc., Doubleday Publishing Co., Inc., American Broadcasting Companies, Inc., and Dell Publishing Co., Inc.

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NO.

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EMMA LEE PAUL,

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CO., INC.,

Respondents.

PETITION FOR A WRIT OF
CERTIORARI TO THE UNITED STATES COURT OF
APPEALS FOR THE SECOND CIRCUIT

To the Honorable, the Chief Justice and
Associate Justices of the Supreme Court
of the United States.

Petitioner, Emma Lee Paul,
respectfully petitions this Court,
pursuant to 28 U.S.C. §1254(1) and Rule
19 of the Rules of this Court, for a Writ
of Certiorari to the United States Court
of Appeals for the Second Circuit to
review the Order of that Court entered in
the case of Paul v. Haley, et al. on
November 9, 1983, Case No. 83-7105.

OPINIONS BELOW

The Order of the United States Court
of Appeals for the Second Circuit is
unreported and is set forth in Appendix A
beginning at page A-23. The Judgment of
the United States District Court is set
forth in Appendix A at page A-21 and the
Memorandum and Order of the District
Court is set forth in Appendix A
beginning at page A-17. The Report and

Recommendation of the United States Magistrate is set forth in Appendix A beginning at page A-1.

JURISDICTION

The Order of the United States Court of Appeals for the Second Circuit was entered on November 9, 1983. This Court has jurisdiction to review the Order of the Court of Appeals pursuant to 28 U.S.C. §1254(1).

STATUTES INVOLVED

The following statutes are pertinent to this case:

28 U.S.C. §1338:

(a) The district courts shall have original jurisdiction of any civil action arising under any Act of Congress relating to patents, plant variety protection, copyrights and

trade-marks. Such jurisdiction shall be exclusive of the courts of the states in patent, plant variety protection and copyright cases.

(b) The district courts shall have original jurisdiction of any civil action asserting a claim of unfair competition when joined with a substantial and related claim under the copyright, patent, plant variety protection or trade-mark laws.

McKinney's Consolidated Laws of New York, Civil Practice Law and Rules:

§213

The following actions must be commenced within six years:

* * *

8. an action based upon fraud; the time within which the action must be commenced shall be computed from the time the plaintiff or the person under whom he claims discovered the fraud, or could with reasonable diligence have discovered it..

STATEMENT OF THE CASE

On December 30, 1981, Petitioner, Emma Lee Paul, filed a Complaint in the United States District Court for the Eastern District of New York (Civ. 81-4163) against Respondents, Alex Haley, Doubleday & Company and Doubleday Publishing Company, Inc. (hereinafter referred to jointly as "Doubleday"), and American Broadcasting Companies, Inc. (Hereinafter referred to as "ABC"). On February 11, 1983, Petitioner filed an Amended Complaint which included claims against Respondent Dell Publishing Co., Inc. (hereinafter "Dell"). The First and Third Causes of Action alleged that Respondents had infringed a copyrighted book written by Petitioner entitled The Bold Truth by the publication of Alex Haley's book Roots and the broadcasting

of the televised version of Roots. The Second Cause of Action charged Doubleday with unfair competition.

Jurisdiction of the U.S. District Court over the copyright infringement claims was based on 28 U.S.C. §1338(a), which expressly vests exclusive original jurisdiction of any civil action arising under federal copyright laws in the District Courts. Jurisdiction of the unfair competition claim was based on 28 U.S.C.A. §1338(b) which expressly vests original jurisdiction of any civil claim asserting such a claim in the District Courts when joined with a related federal copyright claim.

The Amended Complaint alleged that Petitioner had secured a federal copyright registration for The Bold Truth on April 1, 1976, for a publication of

the book made on March 26, 1976. (A copy of Petitioner's Certificate of Registration (No. A 731,165) was attached to the Amended Complaint as Exhibit A.) The Complaint alleged in Count I that Respondents Haley, Doubleday and Dell had, subsequent to Petitioner's securing of copyright protection for The Bold Truth, published the book Roots which had copied significant amounts of The Bold Truth. Count III of the Amended Complaint alleged that ABC, along with the other Respondents, had further infringed Petitioner's copyright by broadcasting television versions of Roots in February 1979. A list of thirty-seven similarities between The Bold Truth and Roots was attached to the Complaint and Petitioner later asserted an additional

eighty-four similarities between her book and the television versions of Roots.

In Count II of the Complaint, Petitioner alleged that she had submitted a manuscript of The Bold Truth to Doubleday on several occasions in 1974 and that Doubleday had retained the manuscript for at least seven months before returning it to her. The Complaint alleged that Petitioner's manuscript was available to Haley and his editors while it was at Doubleday and that Doubleday had made the manuscript available to Haley without Petitioner's permission. Haley's book Roots was published in 1976, subsequent to the date of Petitioner's copyright.

Petitioner requested a trial by jury and prayed for compensatory and punitive damages.

In their Answers, Respondents Haley, Doubleday and Dell denied the allegations of the Amended Complaint alleging copyright infringement but, as to each of the allegations of Count II regarding the unfair competition claim, such Respondents pleaded insufficient knowledge or information to form a belief. Dell's answer was dated March 17, 1982, and Doubleday's and Haley's answers were dated June 29, 1982.

On July 16, 1982, Respondents Haley, Doubleday and Dell filed a Motion for Summary Judgment to Dismiss the Complaint on the ground that no substantial similarity existed between The Bold Truth and Roots. Respondents' Motion was based entirely on Petitioner's Complaint, her answers to interrogatories, her deposition and the two books in question.

While said Motion was pending, Haley was served with Interrogatories and the deposition of Doubleday had been noticed by Petitioner, but no such discovery ever took place. On September 24, 1982, the United States Magistrate for the Eastern District of New York issued his Report and Recommendation on the Motion for Summary Judgment to the District Court Judge. (Appendix A-1.) For purposes of the Motion for Summary Judgment, the Respondents conceded Haley's access to Petitioner's literary work. While acknowledging that "the requirement that lay observers decide the issue of substantial similarity has traditionally precluded a grant of summary judgment," and despite the fact that Petitioner had set forth thirty-seven instances of similarity between her book and Roots and

eighty-four instances of similarity with the television versions, the Magistrate found that there was no copyright infringement of Plaintiff's book, as a matter of law, and he recommended dismissal of Counts I and III of the Complaint. He recommended dismissal of Count III against ABC, even though ABC had not joined in the Motion for Summary Judgment.

With respect to the unfair competition claim of Count II, the Magistrate found that the Motion for Summary Judgment could not be sustained based on the facts before him and that the Petitioner was entitled to the opportunity to develop that cause of action in a trial. Nevertheless, the Magistrate recommended dismissal of Count II for lack of pendent jurisdiction,

since he had found that the related federal claims could not stand. He stated that this recommendation was governed by "considerations of judicial economy, convenience and fairness to litigants."

By an Order dated December 29, 1982, (Appendix A-17) Circuit Court Judge George C. Pratt, sitting by designation, accepted and approved the Magistrate's recommendations and ordered the dismissal of Counts I and III of the Amended Complaint on their merits and Count II for lack of pendent jurisdiction. Judgment on the Order was entered on January 5, 1983. On February 25, 1983, Petitioner filed a Motion for Reargument and/or Reconsideration of the decision on Respondents' Motion for Summary Judgment.

On May 2, 1983, Judge Pratt denied Petitioner's Motion.

The case was subsequently appealed to the United States Court of Appeals for the Second Circuit. In an Order entered on November 9, 1983, the Court affirmed the District Court's grant of Summary Judgment on the basis of a lack of similarity between Petitioner's book and Roots. The Circuit Court affirmed the action of the District Court "in all respects," but it did not set forth any discussion of the dismissal of the unfair competition claim in Count II.

REASONS FOR GRANTING THE WRIT

- I. The Decision of the Court Below to Affirm the Dismissal of a Pendent State Claim Which May Have Become Time-Barred is in Conflict with the Decisions of the Courts of Appeals of Other Circuits, is a Departure from the Accepted Course of Judicial Proceedings and Presents an Important Question Which Should be Resolved by This Court.

As alleged in Petitioner's Amended Complaint, Doubleday had allowed Haley to have access to Petitioner's manuscript while it was in the possession of Doubleday in 1974. Thereafter, in 1976, subsequent to the date of Petitioner's copyright, according to the Complaint Respondents Doubleday and Haley published Roots, which had copied from Petitioner's work. Under New York Law, a claim of fraud must be filed within six (6) years from the date that the fraud was or, with reasonable diligence, could have been discovered. N.Y. CPLR §213 (8).

Assuming that a New York Court might rule that the first date on which Petitioner could have discovered the alleged fraud was when Roots was first published, which, as alleged in the Complaint, was sometime between April 1, 1976, and December 31, 1976, the statute of limitations on Petitioner's unfair competition claim would have run between April 1, 1982 and December 31, 1982. The original complaint was filed in the District Court in December 1981, a year prior to the date that the action would have become time-barred. When the District Court issued its Memorandum and Order on December 29, 1982 (again, assuming a six year limitations period from the date of Roots' publication in 1976), the statute of limitations probably had run, and when judgment was

entered on January 5, 1983, a state action on the unfair competition would have become time-barred.

The Magistrate's Report and Recommendation issued on September 24, 1982, found that Count II of Petitioner's Complaint did state a cause of action for unfair competition, but it recommended that that Count be dismissed in the exercise of the Court's discretion, on the ground that the related federal claims were found to have been without merit. The Report stated that the dismissal of Count II was to be without prejudice to Petitioner's right to file the action in state court. Judge Pratt's Order of December 29, 1982, dismissed Count II "for lack of pendent jurisdiction" without further comment. The Second Circuit's affirmance, issued

on November 9, 1983, did not discuss the pendent jurisdiction issue at all and merely stated that the action of the District Court was affirmed "in all respects." At no time did the Magistrate, District Court or Circuit Court ever discuss or consider the fact that Petitioner's right to file the unfair competition claim might have been barred completely by the running of the applicable statute of limitations during the pendency of the federal action. As the Magistrate correctly stated, the issue of whether pendent jurisdiction should be retained once the federal claims have been dismissed is governed by consideration of fairness to the litigants. Obviously, nothing could be more unfair to a litigant than the dismissal of a valid claim which was

timely filed in federal court but which the litigant had become barred from bringing in state court.

As this Court has held, the dismissal of an underlying federal claim does not deprive a federal court of the power to decide a related pendent claim.

Rosado v. Wyman, 397 U.S. 397, 90 S.Ct. 1207, 25 L.Ed.2d 440 (1970). Hurn v. Oursler, 298 U.S. 238, 53 S.Ct. 586, 77 L.Ed. 1148 (1932). See also Sunbeam Lighting v. Pacific Associated Lighting, Inc., 328 F.2d 300 (9th Cir. 1964), Wham-O Mfg. Co. v. Paradise Manufacturing Co., 327 F.2d 748 (9th Cir. 1964).

As stated in Rosado v. Wyman:

We are not willing to defeat the common sense policy of pendent jurisdiction ... by a conceptual approach that would require jurisdiction over the primary claim at all stages as a prerequisite to resolution of

the pendent claim. The Court has shunned this view.

The question of whether or not a pendent claim should be dismissed is not one of power but rather are for the exercise of the court's discretion.

Rosado v. Wyman, *supra*; UMW v. Gibbs, 383 U.S. 715, 86 S.Ct. 1130, 16 L.Ed.2d 218 (1966), State of Arizona v. Cook Paint and Varnish Co., 541 F.2d 226 (9th Cir. 1976). But discretion of the court is not unfettered; it is "not left to the court's inclination, but to its judgment; and its judgment is to be guided by sound legal principles." Network Project v. Corporation for Public Broadcasting, 561 F.2d 963, 970 (D.C. Cir. 1977), quoting Albermarie Paper Co. v. Moody, 422 U.S. 405, 416, 95 S.Ct. 2362, 2371; 45 L.Ed.2d 280, 296 (1975), quoting in turn United States v. Burr, 25 F.Cas. No.

14,692d, pp. 30, 35 (Cir. Ct. Va. 1907) (No. 14). As has often been stated, one of the key principles to be considered is fairness to the litigants. UMW v. Gibbs, supra, Network Project v. Corporation for Public Broadcasting, supra.

In exercising its discretion as to whether or not a pendent claim should be dismissed, fairness requires that the district court first determine that the plaintiff not have become totally precluded from seeking relief on an otherwise valid claim because of the running of the statute of limitations since the filing of the federal action. In UMW v. Gibbs, supra, this Court indicated that where federal claims are dismissed prior to trial, the state claims should be dismissed as well. 383 U.S. at 726, 86 S.Ct. at 1139. However,

as this Court's decision in Rosado v. Wyman, supra, showed, there are circumstances where the proper exercise of the district court's discretion would require that the pendent claim be maintained in federal court, even where the underlying claim is dismissed prior to trial. Thus, dismissals of the underlying actions in Rosado for mootness and in Network Project v. Corporation Project Broadcasting for failure to state a claim were determined not to justify dismissal of the pendent claims. As stated by the 9th Circuit in State of Arizona v. Cook Paint and Varnish Co., supra, "The continued viability of the Gibbs dictum has been questioned." 541 F.2d at 227. And as stated in In re Carter, 618 F.2d 1093, 1105 (5th Cir. 1980), "any speculation that Gibbs

required dismissal when all federal claims were eliminated before trial was soundly quieted in Rosado v. Wyman." The question of whether a pendent claim should be dismissed on jurisdictional grounds, when such a dismissal will deny the plaintiff of all opportunity to obtain relief due to the passing of the time for filing an action in state court, is an important question which has not been addressed by this Court and which should be resolved by it.

Every federal court of appeals which has dealt with this issue has ruled that the dismissal of a state claim for lack of jurisdiction when such a dismissal would leave the plaintiff without a forum in which to seek relief is an abuse of discretion. Thus in O'Brien v. Continental Illinois National Bank &

Trust, 593 F.2d 54 (7th Cir., 1979), the Court of Appeals for the Seventh Circuit determined that the District Court had dismissed the pendent state claims at a time when they might have become barred by the statute of limitations, even though they had been timely filed in federal court and stated:

Under these circumstances, plaintiffs should have been permitted to pursue their pendent state claims in the federal actions.... At least when, as here, a plaintiff has pursued his federal claim in good faith and with diligence, his pendent claim should not be foreclosed by the passage of the time required to dispose of the federal claim. 593 F.2d at 65.

The Court held that the District Court had abused its discretion in dismissing the claims.

In Pharo v. Smith, 625 F.2d 1226 (5th Cir., 1980), the Fifth Circuit Court

of Appeals stated that whether a plaintiff's state law claims will be time-barred if dismissed is "certainly a factor, if not a determinative factor," which should be considered by a district court in deciding whether to maintain jurisdiction over the state claims once the federal claims have been resolved. The Court remanded the action for reconsideration of the order dismissing the state claims, even though the statute of limitations problem was first brought to the Court of Appeals' attention in a motion for rehearing, and the Court could not determine whether the issue had been presented to the District Court. The Court stated: "Though plaintiffs have delayed in calling this statute of limitations problem to the court's attention, we think the problem deserves

consideration; the appropriate forum to consider it is the district court." 625 F.2d at 1227.

In two more recent cases, the 5th Circuit has continued to follow the rule set in Pharo v. Smith, supra. In Henson v. Columbus Bank and Trust Co., 651 F.2d 320 (5th Cir., 1980) the district court had declined jurisdiction over a pendent claim and then denied the plaintiff's motion seeking reconsideration of that order which the plaintiff brought because the statute of limitations barred him from litigating the claim in the state courts. The district court had been unaware of the statute of limitations issue at the time of the initial order. The Fifth Circuit Court of Appeals ruled that the district court should have granted the plaintiff's motion for

reconsideration and had erred by failing to do so. In Rheaume v. Texas Dept. of Public Safety, 666 F.2d 925 (5th Cir., 1982) the Fifth Circuit once again dealt with this issue and stated that before deciding not to exercise its pendent jurisdiction the district court was obligated "to request appropriate briefing and argument from the parties and to exercise its discretion in light of the answer to the question of the availability of a state forum." 666 F.2d at 932. The Court pointed out that even after a district court has dismissed a claim for lack of pendent jurisdiction, it should grant a motion for reconsideration if the plaintiff later finds that his case cannot be brought in state court because it has become time-barred. 666 F.2d at 932.

The Eleventh Circuit has also considered this issue and its decisions are consistent with those of the Fifth and Seventh Circuits. Thus, in Stein v. Reynolds Securities, Inc., 667 F.2d 33 (11th Cir., 1982), the Court remanded the case since the record was silent as to whether the district court was aware that the state claim was barred by the state period of limitations. The Court held that "a federal court may retain jurisdiction over a state claim which is barred by the state period of limitations, even though all federal claims have been dismissed..." 667 F.2d at 34.

Similarly in Quality Foods v. Latin American Agribusiness Development Corporation, 711 F.2d 989 (11th Cir., 1983), the Court stated that the question

of whether there is a potential statute of limitations bar is a "necessary consideration" in determining whether to deny pendent jurisdiction, and remanded the case to the district court for reconsideration of this issue. It did so even though the delays in the federal action were attributed to the plaintiffs and, the Court noted, the plaintiffs had not brought the limitations problem to the attention of the district court and had not attempted to file a state court suit. The Court stated that the district court was to be given an opportunity to consider the potential limitations problem "even at this late date." 711 F.2d at 991.

In Federman v. Empire Fire and Marine Ins. Co., 597 F.2d 798 (2nd Cir., 1979), the Second Circuit itself

recognized that the retention of pendent jurisdiction due to the possible running of a state statute of limitations was not an abuse of discretion. However, in the instant case the Court of Appeals affirmed the dismissal of a pendent claim where the statute of limitations may have run. Under the decisions of the Fifth, Seventh and Eleventh Circuits, such a dismissal would be an abuse of discretion, and a remand would be required - even if the limitations issue had not been brought forth until a later time. The Second Circuit's treatment of this case is inconsistent with that of the other Circuits. The granting of the Writ because of this inconsistency as well as the importance of the issue involved would be appropriate. In addition, the supervisory authority of

this Court should be exercised to require federal courts to assure that claimants will not be deprived of all opportunity for relief by the running of a limitations statute before dismissing pendent claims legitimately before them.

II. The Issue of Whether a Copyright Infringement Action Should Be Allowed To Proceed To Trial Where Similarities Have Been Shown and Access Is Not In Issue Presents An Important Question Which Should Be Settled By This Court.

It has often been stated that a defendant's motion for summary judgment in a copyright infringement action on the ground of lack of substantial similarity should not be granted where there is any reasonable doubt on the issue of copying.

Nimmer on Copyright, §12.10, at 12-71 (1983); Arnstein v. Porter, 154 F.2d 464 (2nd Cir., 1946). In Arnstein, the

Second Circuit Court of Appeals held that a plaintiff in an infringement action is entitled to a trial of the action if "there is the slightest doubt as to the facts." 154 F.2d at 468. See also Morrissey v. Procter & Gamble Company, 370 F.2d 675 (1st Cir., 1967); Goodson-Todman Enterprises, Inc. v. Kellog Co., 513 F.2d 913 (9th Cir., 1975). The Court in Arnstein stated that if there is evidence of access and any similarities exist, it is up to the trier of fact to then determine whether the similarities are sufficient to prove copying. Whether there is substantial similarity is not determined solely by the quantity of similarity. If the similar material is qualitatively important, the trier of fact may properly find substantial similarity even if there

are very few actual instances of similarity. Nimmer, §13.03 [A] at 13-34 - 13-35 and cases cited at n. 56. Hein v. Universal Pictures, 154 F.2d 480, 487 (2nd Cir., 1946). The amount of similarity which will cross the line of "substantial similarity" has been said to present a classic jury question. Roy Export Co. Establishment v. Columbia Broadcasting System, Inc., 503 F.Supp. 1137, 1145 (S.D. N.Y., 1980) aff'd 672 F.2d 1095 (2nd Cir., 1982). And Nimmer points out that where there is proof of access (here it was admitted for purpose of the Summary Judgment Motion) the required degree of similarity is less than would be necessary in the absence of such proof. Nimmer, §13.03 [D].

Although the Magistrate in the instant case attempted to distinguish

away the Arnstein rule, the Second Circuit has stated, as recently as 1980, that, "Because substantial similarity is customarily an extremely close question of fact...summary judgment has traditionally been frowned upon in copyright litigation...." citing Arnstein. Hoehling v. Universal City Studios, Inc., 618 F.2d 972, 977 (2nd Cir., 1980). The Court in Hoehling pointed out that Arnstein is not applicable to any non-copyrightable elements of the plaintiff's work, but indicated that it was otherwise still applicable to copyright cases.

In the instant case, Petitioner presented approximately one hundred instances of similarities between her copyrighted work and Respondents' allegedly infringing works. That

similarities between the two works do in fact exist cannot be denied. */ The Magistrate's Report and Recommendation, upon which the District Court and the Court of Appeals' decisions were based, did not find that there were no similarities but that, as a matter of law, whatever similarities did exist did not warrant a finding of infringement.

This is not a case in which there is a complete absence of similarity or

*/ To illustrate just a few of those alleged: both works described slaves putting their heads in a pot/bucket to pray; both describe a woman giving childbirth over a cloth on the floor; both use a coined word "haints"; both describe putting sweet potatoes to cure under straw; both discuss white masters in white suits smoking cigars; both refer to blacks poisoning whites.

alleged copying only of non-copyrightable work. And, since access was conceded for purposes of the motion, the level of similarity needed to warrant a finding that copying had occurred is much less than would otherwise be the case. In these circumstances, the issue of whether the similarities between the works were enough to constitute "substantial similarities" was a matter for the trier of fact (in this case a jury) - to be determined after a full trial on the issue. Arnstein v. Porter, supra.

The issue of whether a claimant in a copyright infringement action is entitled to a trial on the issue of copying, where similarities clearly exist and where access is not an issue, is an important question of federal law which has not been, but should be, settled by this

Court. Further, the Court of Appeals' grant of Respondents' Motion for Summary Judgment, thus denying Petitioner her right to a jury trial on disputed issues of fact, in a case where such issues did in fact exist is a departure from accepted judicial practice which this Court should review.

CONCLUSION

For the foregoing reasons, the Court should grant the Writ of Certiorari.

Respectfully submitted,

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February 7, 1984

APPENDIX

APPENDIX

A-1

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF NEW YORK

EMMA LEE PAUL,

REPORT AND
RECOMMENDATION
TO JUDGE PRATT*

Plaintiff,

-against-

CV-81-4163

ALEX HALEY; DOUBLEDAY & COMPANY;
DOUBLEDAY PUBLISHING COMPANY, INC.;
AMERICAN BROADCASTING COMPANIES, INC.;
and DELL PUBLISHING COMPANY, INC.,

Defendants.

This is a motion by all defendants
other than the American Broadcasting Com-
panies for summary judgment in a copy-
right infringement suit. Defendants are
the author, publishers and broadcasters
of the book Roots, a widely publicized,
best-selling depiction of the author's
family history from the birth of an
African ancestor in 1750 to that of the
author. Plaintiff claims her copy-
righted autobiographical book, The Bold

Truth, was infringed by Haley during the preparation of his book. She alleges that Roots' original publisher, defendant Doubleday and Company (Doubleday), had her book in its possession during its editing of defendant Alex Haley's work and that there are several points of similarity between the two works. Defendants request a dismissal on the grounds that there are no triable issues of fact and that as a matter of law there is no substantial similarity between the two works.

* Honorable George C. Pratt, to whom this case was originally assigned, is now a judge of the Court of Appeals sitting in this district by designation. He retains responsibility for his assigned cases. He has referred this case to the undersigned magistrate for the completion of pretrial proceedings, including recommendation as to disposition of dispositive motions.

Two threshold questions arise.

First, defendants have not submitted a Rule 9(g) statement. They base their motion entirely upon plaintiff's complaint, her answers to interrogatories, deposition testimony and the two books involved, all of which have been filed with the court, and so claim it is unnecessary. The facts are presented with clarity. A Rule 9(g) statement would not materially assist in resolving the issues presented. It is, therefore, waived in this instance.

Second, plaintiff requests that action on this motion be delayed in order to permit discovery on the question of defendants' access to plaintiff's work. However, access is conceded for purposes of defendants' motion.

The complaint contains three causes of action. I. Copyright infringement by Haley, Doubleday and Dell by publishing "Roots". II. Unfair competition by Doubleday in making the manuscript of "The Bold Truth" available to Haley's editors during the preparation of "Roots". III. Copyright infringement by Haley, Doubleday, Dell, and the American Broadcasting Co. by televising "Roots - The Next Generation".

COUNT I

To establish infringement plaintiff must prove that defendant copied or had sufficient access to her copyright works to infer copying and that there are sufficient similarities between the works to convince a lay observer that defendant had improperly appropriated her

expression. Arnstein v. Porter, 154 F.2d 464, 468 (2d Cir. 1946); Heim v. Universal Pictures Co., 154 F.2d 480, 487 (2d Cir. 1946); Alexander v. Haley, 460 F. Supp. 40, 43 (S.D.N.Y. 1978). Since defendants are conceding access for purposes of this motion, the only questions before this court are whether the alleged similarities are protectable by copyright and, if they are, whether they are so "devoid of factual or legal substance" as to make a jury determination unnecessary. Alexander v. Haley, 460 F. Supp. at 44.

The requirement that lay observers decide the issue of substantial similarity has traditionally precluded a grant of summary judgment. Arnstein v. Porter, 154 F.2d at 474. However, recent cases in the Southern District

have granted summary judgment where claims of similarity applied only to non-copyrightable elements of a plaintiff's work. Hoehling v. Universal City Studios, Inc., 618 F.2d 972, 977 (2d Cir., cert. denied, 449 US 841 (1980)); Alexander v. Haley, 460 F. Supp. 40; Musto v. Meyer, 434 F. Supp. 32 (S.D.N.Y. 1977); Gardner v. Nizer, 391 F. Supp. 940 (S.D.N.Y. 1975); Fuld v. National Broadcasting Co., 390 F. Supp. 877 (S.D.N.Y. 1975). This trend permits courts to put "a swift end to meritless litigation" and avoid lengthy and costly trials. Quinn v. Syracuse Model Neighborhood Corp., 613 F.2d 438, 445 (2d Cir. 1980).

A comparison of the allegedly similar points does not disclose any

misappropriation of plaintiff's expression. There are common metaphors and occasional common words. (E.g., "sea of white faces" appears in Roots at page 570 and in The Bold Truth at page 155. "Mouth watering" appears in Roots at page 379, and The Bold Truth at page 115). A minor character in Roots has the same first name as the plaintiff and is described as being "black, sorta fat". The plaintiff feels this is a description of herself. A few events common to the experience of blacks in the South appear in both books, but in very different contexts and in different words. Each of the alleged similarities has been compared. Some are so strained as to defy the imagination. None approach infringement.

Not only is it questionable "whether the resemblance between the two works in question could be recognized by ordinary observation," Greenbie v. Noble, 151 F. Supp. 45, 70 (S.D.N.Y. 1957) but the plaintiff herself had difficulty. "I went through the book several times. I would say I read over and over and over, and I would pass by things and did not see it. I read it five times I would read over things that did not make sense. He was not making any sense. He was so weaved, like I say, it was hard to get it out." (Paul Tr. 40-41).

Plaintiff argues that the number of similarities in the two works is statistically so unlikely as to negate the possibility of their being coincidences. This confuses probability theory, which is based on random events from a large

universe, with the frequent appearance of similar words, concepts, themes and events in works reflecting a common cultural experience. Indeed, it is statistically unlikely that two authors writing about blacks in the South would not have many coincidences. If such coincidences, particularly ones as tenuous as those in these two works, were found to be copyright infringement, future writers would be starved for material.

Plaintiff seems to feel that, because Haley or his editors might have read her book and might have been influenced by it, she is damaged. Even if such allegations were true, they do not constitute copyright infringement.

Gero v. The Seven-Up Company, 535 F. Supp. 212, 216 (E.D.N.Y.1982). While a

literal word-for-word reproduction is not the standard for infringement, either "the fundamental essence or structure of a substantial part of one work" must be "duplicated in another" or there must be a "substantial number of instances of literal similarity between the two works."

Werlin v. Reader's Digest Association, Inc., 528 F. Supp. 451, 462 (S.D.N.Y. 1981). The "coincidences" that the plaintiff puts forward as the basis for her suit do not fit either of these patterns even remotely.

For these reasons Count I should be dismissed.

COUNT III

This count charges all the foregoing defendants, as well as the American Broadcasting Companies (ABC) with copy-

right infringement resulting from ABC's televising of "Roots - The Next Generation". This count specifies precisely the same allegations as are made in Count I, no more and no less. Indeed, they are incorporated by reference.

Since the broadcast version of Roots was based on the book, and since no facts specific to the former are alleged to constitute an independent copyright infringement, a finding that the book did not infringe necessarily means that the broadcast did not infringe either. The movant's motion to dismiss the third count should be granted. ABC did not join in this motion. On the court's own motion it should be dismissed as to ABC as well on this count for the possibility of infringement has been negated.

COUNT II

Summary judgment on the first and third causes of action does not effect the second cause of action for unfair competition. Nor does it affect a possible cause of action based on implied contract. The plaintiff does not present any factual allegations or provide any legal argument to substantiate these complaints separate from those of her copyright infringement claim. Indeed, the possibility of a cause of action in implied contract is merely a phrase occasionally inserted in the papers. Nonetheless, defendant's claim that "where there has been no copyright infringement, there can be no claim for unfair competition based on the same facts" is incorrect. Reply memorandum at 8. While courts have

generally refused to find unfair competition where plaintiff did not hold a copyright, it is still a separate tort independent of copyright infringement. In New York this tort exists when a defendant misappropriates the labor and expenditures of another.

Saratoga Vichy Spring Co. v. Lehman,
625 F.2d 1037, 1044 (2d Cir. 1980).

In order to establish misappropriation, plaintiff must prove "(1) that the defendant obtained access to the idea through an abuse of a fiduciary or confidential relationship with the plaintiff or via some sort of fraud or deception... (Cites omitted); and (2) that the defendant's use of the idea deprived the plaintiff of the opportunity to reap its due profits on the idea." Werlin V. Reader's

Digest Association, 528 F. Supp. at 464.

Since defendants have conceded access for the purposes of their motion for summary judgment, they cannot deny it as it applies to the claim of unfair competition. While plaintiff has not shown damages, neither has she failed to establish that fact. Thus the motion for summary judgment cannot be sustained on this issue from the facts at hand.

The claim of implied contract is so undeveloped that it is questionable whether plaintiff has even asserted a cause of action. In order to substantiate such a cause of action, plaintiff must show that "defendant has benefitted from its use of an idea generated by the plaintiff... (and that) the circumstances make it inequitable for the defendant to profit from the use of

plaintiff's idea or material." Werlin, 528 F. Supp. at 465. While it is not clear from the papers that plaintiff will be able to do this, the court will permit her that opportunity.

However, that option must be pursued in state court. The pendent jurisdiction of the federal court over state claims is discretionary. Once the federal claims have been dismissed retention should be governed by "considerations of judicial economy, convenience and fairness to litigants" with unnecessary "decisions of state law avoided both as a matter of comity and to promote justice." As a general rule "if the federal claims are dismissed before trial, even though not insubstantial in a jurisdictional sense, the state claims should be dismissed as well."

United Mine Workers v. Gibbs, 383 US 175, 726 (1966). These considerations prompt the court to dismiss the complaint as to the second cause of action without prejudice to the rights of plaintiff to file in state court.

CONCLUSION

Summary judgment should be granted dismissing Counts I and III on their merits. Count II should be dismissed for lack of pendent jurisdiction.

I so recommend.

Any objections to this report and recommendation must be filed with Judge Pratt by October 8, 1982.

Dated: Uniondale, New York
September 24, 1982

DAVID F. JORDAN
United States Magistrate

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF NEW YORK

EMMA LEE PAUL, DOCKET NO. CV81-4163

Plaintiff,

-against- MEMORANDUM AND ORDER

ALEX HALEY; DOUBLEDAY & COMPANY;
DOUBLEDAY PUBLISHING COMPANY,
INC.; AMERICAN BROADCASTING
COMPANIES INC.; and DELL PUBLISH-
ING COMPANY, INC.,

Defendants.

APPEARANCES:

JAMES P. MALONE
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COUDERT BROTHERS
By Michael J. Calvey
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Broadcasting Co.
200 Park Avenue
New York, New York 10166

PRATT, C.J.:

In a report and recommendation dated September 24, 1982, Magistrate David F. Jordan recommends that summary judgment should be granted dismissing counts I and III on the merits, and that count II should be dismissed for lack of pendent jurisdiction. The court has reviewed carefully the plaintiff's objections to the magistrate's report and recommendation and has considered the matter de novo, including all of the papers submitted to the magistrate on the motion. After careful deliberation, the court accepts and approves the magistrate's recommendation.

By dismissing against defendant American Broadcasting Companies, Inc. (ABC), the magistrate granted relief to a party who had not yet requested it. Although plaintiff objects on the ground that one of the TV shows, "Roots - The

"Next Generation", contains 47 "additional coincidences" beyond those claimed to have been copied from the book, the claim that the television show was different from the book situation runs counter to the complaint which in count III merely incorporates the instances of copying that are specified in count I, referring to the book. Even considering them as separate "coincidences", the analysis and conclusions of the magistrate apply equally to the additional 47. Whether viewed separately or together, the claimed "coincidences" are insufficient to raise a triable issue of fact as to the substantial similarities that would be necessary to support plaintiff's claim of copyright infringement against the defendants, individually or collectively.

Accordingly, the clerk shall enter judgment dismissing counts I and III on their merits, and dismissing count II for lack of pendent jurisdiction.

SO ORDERED.

Dated: Uniondale, New York
December 29, 1982.

GEORGE C. PRATT
U.S. CIRCUIT JUDGE*

* Of the United States Court of Appeals for the Second Circuit, sitting by designation.

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF NEW YORK

EMMA LEE PAUL,

CV 81-4163

Plaintiff

(G.C.P.)

v.

JUDGMENT

ALEX HALEY ET AL

A memorandum and order of the honorable George C. Pratt, United States Circuit Judge, having been filed on January 5, 1983, approving the Magistrate's report and recommendation dated September 24, 1982, dismissing counts I and III on the merits, and that count II is dismissed for lack of pendent jurisdiction, it is,

ORDERED and ADJUDGED that the plaintiff take nothing of the defendants and that counts I and III is dismissed on the merits and count II is dismissed for lack of pendent jurisdiction.

Dated: Uniondale, New York
January 5, 1983

Richard H. Weare
Clerk of Court

By: George L. Vazoulas
Deputy Clerk

UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT

At a stated Term of the United
States Court of Appeals for the Second
Circuit, held at the United States
Courthouse in the City of New York, on
the 9th day of November , One
Thousand Nine Hundred and Eighty-three.

PRESENT:

HON. WILLIAM H. TIMBERS
HON. LAWRENCE W. PIERCE
HON. CARL McGOWAN*
Circuit Judges.

Filed
November 9, 1983
United States
Court of Appeals
For the Second
Circuit

EMMA LEE PAUL

Plaintiff-Appellant,

v.

ORDER
83-1705

ALEX HALEY, DOUBLEDAY & CO.,
DOUBLEDAY PUBLISHING CO.,
AMERICAN BROADCASTING CO. and
DELL PUBLISHING CO.

Defendants-Appellees.

*Of the D.C. Circuit Court of Appeals, sitting
by designation.

Appellant appeals from an order of the United States District Court for the Eastern District of New York (Pratt, C.J., sitting by designation), entered January 5, 1983, granting summary judgment in favor of all defendants and dismissing the complaint herein.

Paul is the author of an unpublished autobiographical manuscript entitled The Bold Truth. Based on the recollections of Paul and her friends and family, The Bold Truth traces the author's experience as a black woman and mother living in the South up to and through her relocation to Long Island, New York, where she built a home and raised her children. Defendants are, respectively, the author, publishers and broadcasters of the book Roots, a widely publicized depiction of the author's family history from the

birth of an African ancestor circa 1750 up to the lifetime of the author.

Paul sets forth three claims in her complaint. Count I alleges copyright infringement by Alex Haley ("Haley"), Doubleday & Co. and Doubleday Publishing Co. (jointly "Doubleday"), and Dell Publishing Co. ("Dell") based on the publication and circulation of Roots, which allegedly was copied substantially from The Bold Truth. Count II charges Doubleday with unfair competition based on its alleged disclosure of Paul's manuscript to Haley's editors during the preparation of Roots. Count III alleges copyright infringement by Haley, Doubleday, Dell and the American Broadcasting Co. ("ABC") based on the televised versions of Roots.

On April 16, 1982, Haley, Doubleday and Dell moved for summary judgment dis-

missing the two copyright charges (Counts I and III) for lack of substantial similarity between The Bold Truth and defendants' works as a matter of law, and the unfair competition claim (Count II) for lack of pendent jurisdiction. Magistrate David F. Jordan, to whom Judge Pratt had referred the motion, issued a report in which he recommended dismissal of Paul's action in its entirety. The report required the parties to file any objections thereto with Judge Pratt.

On October 7, 1982, Paul filed objections to the magistrate's report, arguing that summary judgment should not be granted in favor of ABC since ABC had not sought summary judgment, and that summary judgment was inappropriate as to all defendants because substantial similarities existed between Paul's book and defendants'

works. ABC submitted to Judge Pratt a letter in support of the magistrate's recommendation of summary judgment in its favor. After considering the evidence de novo, Judge Pratt rejected Paul's objections, accepted the magistrate's recommendations and granted the motion for summary judgment.

1. Summary judgment in favor of ABC. As to Paul's contention that the magistrate should not have recommended summary judgment in ABC's favor, it is sufficient to note that Judge Pratt undertook a de novo review of the evidence, including Paul's list of alleged similarities between The Bold Truth and the telecasts of Roots. A district judge, upon motion for summary judgment, can dismiss a complaint even as to a non-moving party. See Lowenschuss v. Kane, 520 F.2d 255, 261

(2d Cir. 1975) (sua sponte award of summary judgment to non-moving party sanctioned where "it appeared from the papers, affidavits and other proofs submitted by the parties that there were no disputed issues of material fact and that judgment for the non-moving party would be appropriate as a matter of law"). Herein, Judge Pratt concluded that "the claimed 'coincidences' are insufficient to raise a triable issue of fact as to the substantial similarities that would be necessary to support plaintiff's claim of copyright infringement against the defendants, individually or collectively."

2. Summary judgment for lack of substantial similarity. Summary judgment in copyright infringement actions is appropriate where there does not exist any similarity as a matter of law between

the works in dispute. See Arnstein v. Porter, 154 F.2d 464, 473 (2d Cir. 1946) (the general preference for "trials in plagiarism suits," does not mean that "a plagiarism case can never arise in which absence of similarities is so patent that a summary judgment for defendant would be correct"), cert. denied, 330 U.S. 851 (1947); Burroughs v. Metro-Goldwyn-Mayer, 683 F.2d 610, 623 (2d Cir. 1982) (summary judgment properly granted where court found that no reasonable jury could find the two works substantially similar beyond the level of generalized ideas or themes"); Hoehling v. Universal City Studios, Inc., 618 F.2d 972, 979 (2d Cir.) (summary judgment entirely appropriate where plaintiff's allegations of copying encompassed material that was non-copyrightable as a matter

of law), cert. denied, 449 U.S. 841 (1980).

We do not find that the district judge erred as a matter of law in granting summary judgment in favor of defendants since our own review shows an absence of similarities between appellant's book and the challenged works.

We affirm the action of the district court in all respects.

Honorable William H. Timbers

Honorable Lawrence W. Pierce

Honorable Carl McGowan

Circuit Judges.